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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,158	04/23/2001	Hirokazu Kawamoto	35.G2785	1598
5514	7590	06/23/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			RUDOLPH, VINCENT M	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/839,158	Applicant(s) KAWAMOTO ET AL.	
	Examiner Vincent M. Rudolph	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-46, 48-52, 54, 61-64 and 66-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-46, 48-52, 54, 61-64 and 66-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43-44, 46, 48-50, 52, 54, 61-62, 64 and 66-72 are rejected under 35 U.S.C. 103(a) as being anticipated by Hicks ('353).

Regarding claim 43, Hicks ('353) discloses an information processing apparatus for producing print data to be printed by a printing apparatus (printing system, See Figure 1) that includes a setting means (the system becomes the means) of setting a plurality of output formats for one piece of data to be printed (a touch screen is used for inputting information to be outputted with different formats, See Col. 6, Line 57-60), producing means (the system becomes the means) for producing a print job (transparencies as a copy output, See Figure 2) that includes a group of job commands and the data to be printed (within the transparencies option, multiple job commands, such as Dividers, Master Set and Handout Set(s), are able to be selected to output the data, See Figure 3), and execution control means (the system becomes the means) for controlling execution such that printing for the plurality of output formats is executed (once the user selects which format and sequence for outputting the formats, See Figure 5, a stack is printed, See Figure 4; Col. 9, Line 58-67).

Hicks ('353) does not disclose producing a single print job, but it would have been obvious to one of ordinary skill to include a single print job that includes a group of job commands to output within the printing system. By having a single print job, such as transparencies, included with additional group of job commands, such as Dividers, Master Set and Handout Set(s), it allows a user to submit the same print data using multiple output formats once rather than having to resubmit the same data using a different output format numerous times.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have included submitting a single print job and incorporate it into the information processing apparatus of Hicks ('353) because it allows a user to not have to resubmit the same print data numerous times for different job commands, but rather group the job commands together within a single print job to output.

Regarding claim 44, Hicks ('353) discloses that the setting means (system becomes the means) is capable of setting a combination of predetermined output formats (the system allows a user to select a predetermined amount of different output formats, such as Dividers, Master Set, Handout Set(s) along with Transparencies, See Figure 3).

Regarding claim 46, Hicks ('353) discloses that the setting means (system becomes the means) is capable of setting an arbitrary combination of output formats (the printing system allows a user to select which output formats to set to print, See Figure 3; Col. 7, Line 54-67).

Regarding claim 48, Hicks ('353) discloses the execution control means (printing system becomes the means) transmits the print job to the printing apparatus (once the user selects the sequence to output the print job, it is sent to the printer / copier together, See Figure 1; Col. 9, Line 58-60).

Regarding claim 67, Hicks ('353) discloses that whenever a command which requests a plurality of output formats is added to the group of job commands, the execution control means (printing system becomes the means) includes converting the data to be printed into print data in the print job so as to execute printing (the image data is prepared to output once the stack is received from the user, See Figure 7; Col. 4, Line 8-10; Col. 9, Line 58-60).

Hicks ('353) does not disclose converting the data for the plurality of output formats more than once, but it would have been obvious to one of ordinary skill in the art to have done so. For example, by having the single print job with multiple formats converted multiple times, a user has to only submit the single job once, which reduces the number of times a user has to resubmit a different formatted print job.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have included converting the print data multiple times and incorporate it into the information processing apparatus of Hicks ('353) because it allows a user to only submit the single print job with multiple output formats once, which reduces the print queue for the user if more than one user submits print jobs to be outputted.

Regarding claim 68, Hicks ('353) discloses that the producing means (printing system becomes the means) adds a command to specify the plurality of output formats into the group of job commands in the print job (a user adds a command, such as selecting which formats to use, See Figure 3; Col. 7, Lin 54-67, so that the group job is outputted as a stack print job, See Figure 4; Col. 9, Line 58-60).

Regarding claims 49-50, 52, 54, 61-62, 64, 66, 68-72, the rationale provided in the rejection of claims 43-44, 46, 48 and 67-68 are incorporated herein. In addition, the apparatus of claims 43-44, 46, 48 and 67-68 corresponds to the method of claims 49-50, 52, 54 and 69-70 as well as the computer-readable medium (not disclosed, but would have been obvious in order to drive the printing system of Figure 1 as well as having a location to store the user interface program) of claims 61-62, 64, 66 and 71-72 and performs the steps disclosed herein.

Claims 45, 51 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks ('353) in view of Sagman.

Regarding claim 45, Hicks ('353) discloses that the combination of predetermined output formats includes a first format in which one page is output onto one sheet (such as the master set, See Figure 4; Col. 9, Line 10-18).

Hicks ('353) does not disclose having the second output format outputted onto one sheet.

Sagman discloses within Microsoft Power Point, a user can select to have a plurality of pages outputted onto one page (an N-in-1 layout process for an

output format, such as a predetermined number of pages to be put onto one recording paper, See Page 384).

It would have been obvious to one skilled in the art at the time of invention by the applicant to have the N-in-1 layout process as described by Sagman and incorporate it into the information processing apparatus of Hicks ('353) because by adding a predetermined number of pages to print out onto one recording paper, it reduces the amount of paper used for printing the output format.

Regarding claims 51 and 63, the rationale provided in the rejection of claim 45 is incorporated herein. In addition, the apparatus of claim 45 corresponds to the method of claim 51 and the computer-readable medium (not disclosed, but would have been obvious in order to drive the printing system of Figure 1 as well as having a location to store the user interface program) of claim 63 and performs the steps disclosed herein.

Response to Arguments

Applicant argues the prior art does not disclose outputting multiple jobs as a single printing job. Even though the previous prior art does not disclose that limitation, the obviousness combination along with the prior art of Hicks meets the claimed limitations of the applicant. For example, Hicks discloses a printing system, See Figure 1, which has the ability to set multiple output formats, See Figure 3. Once the user designates which formats to have, they are outputted in a sequence chosen by the user, See Figure 4, as a stack, See Col. 9, Line 58-60. Even though Hicks does not fully disclose this outputted sequence as a single print job, it would have been obvious to one of ordinary skill in the art to

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have one within the group of job commands for the printing system of Hicks. The reason is that it allows a user to submit the same print data with different multiple job commands once and not have to resubmit the same data for a different output format numerous times. Thus, the obviousness combination along with the prior art of Hicks meets the claimed limitations of the amended claims. As a result, this action is made **NON-FINAL**.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is: Kakuno ('003).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent M. Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

6/19/06

VMR

Vincent M. Rudolph
Examiner
Art Unit 2625



MARK ZIMMERMAN
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